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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------|-------------------------------|------------------|
| 10/019,065 | 05/31/2002 | Gayle Delmonte Wetzel | MSB-7265-PCT-US | 1911 |
| 7590 Melissa A Shaw Bayer Corporation 800 Dwight Way PO Box 1986 Berkeley, CA 94701 | | | EXAMINER SCHNIZER, HOLLY G | |
| | | | ART UNIT 1653 | PAPER NUMBER |
| DATE MAILED: 10/04/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,065

Applicant(s)

WETZEL, GAYLE DELMONTE

Examiner

Holly Schnizer

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6, 10, 12, and 14, drawn to a method of enhancing angiogenesis by administering a BTL.012-like protein.

Group II, claim(s) 1-6, 10, 12, and 14, drawn to method of inhibiting angiogenesis by administering a BTL.012-like protein.

Group III, claim(s) 1-6, 11, and 13 drawn to a method of enhancing angiogenesis by gene therapy.

Group IV, claim(s) 1-6, 11 and 13, drawn to method of inhibiting angiogenesis by gene therapy.

Group V, claim(s) 7-9 and 21, drawn to a protein at least 60% identical over 40 residues to SEQ ID NO:1.

Group VI, claim(s) s 15-17, drawn to a polynucleotide encoding a protein having a deduced amino acid sequence which is at least 60% identical over 40 residues to SEQ ID NO:1.

Group VII, claim(s) 18, drawn to an antibody against a protein having a deduced amino acid sequence which is at least 60% identical over 40 residues to SEQ ID NO:1.

Group VIII, claim(s) 19-20, drawn to a method of diagnosing a disease.

The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

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The technical feature linking Groups I-VIII appears to be that they all relate to a BTL.012-like protein.

However, as evidenced by the references cited on page 1 of the instant application, BTL.012-like proteins were well known in the art at the time of the invention (the examiner has considered "BTL.012-like" proteins as proteins containing thrombospondin repeat domains).

Therefore, the technical feature linking the inventions of Groups I-VIII does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

The special technical feature of Group I is considered to be methods of enhancing angiogenesis by administering a BTL.012-like protein.

The special technical feature of Group II is considered to be methods of inhibiting angiogenesis by administering a BTL.012-like protein.

The special technical feature of Group III is considered to be a method of enhancing angiogenesis by gene therapy.

The special technical feature of Group IV is considered to be a method of inhibiting angiogenesis by gene therapy.

The special technical feature of Group V is considered to be a protein with 60% identity over 40 residues to SEQ ID NO:1.

The special technical feature of Group VI is considered to be a polynucleotide encoding a protein with 60% identity over 40 residues to SEQ ID NO:1.

The special technical feature of Group VII is considered to be an antibody.

The special technical feature of Group VIII is considered to be a method of diagnosing a disease.

Accordingly, Groups I-VIII are not so linked by the same or corresponding special technical feature as to form a single general inventive concept.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Schnizer whose telephone number is (571) 272-

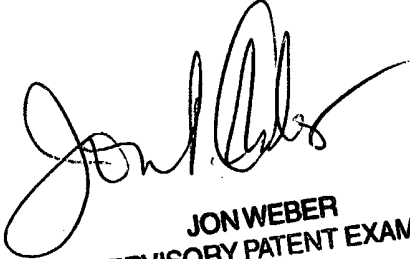
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0958. The examiner can normally be reached on Monday through Wednesday from 8 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Holly Schnizer
September 28, 2004


JON WEBER
SUPERVISORY PATENT EXAMINER